

REMARKS

Status of the Claims

Claim 1, 8 and 9 have been amended. Claims 2-7 and 11 are original claims and Claims 10 and 12 have been previously presented.

Claim Rejections – 35 USC § 102

Claims 1, 2, 4, 8, 9, 11 and 12 were rejected under 35 U.S.C. 102 (b) as being anticipated by Doi et al. (JP 01-202492). Doi's transfer sheet requires the presence of at least a thin metal film layer. Applicants have amended Claims 1 and 9 to a process for producing a backing foil that "consists of" the process steps set forth in the Claims which do not include the presence of a metal film layer. Claims 2-7 are either directly or indirectly dependent on Claim 1 and Claims 10-12 are directly dependent on Claim 9. Claim 8 which is directed to the backing foil has also been amended to "consisting of" and eliminates the presence of the thin film layer that is required by Doi.

As stated in the previous amendment, Applicants specifically disclaim the use of such a metal layer. Applicants above amended claims preclude the presence of a metal film layer. Such a layer is not wanted by Applicants and would obscure the image layer that Applicants are applying. Applicants' invention is directed to a backing foil having a foil layer with one side coated with an uncured or partially cured transparent coating that has an image thereon. This backing foil is placed on a substrate with the image in contact with the substrate and cured and then the foil is removed to provide an image that has a transparent layer thereon. The claims have been amended and are directed to a backing foil that consists of a foil coated on one side with a transparent coating having an image thereon. The claims clearly do not provide for nor were they intended to provide for the presence of a thin metal foil as required by Doi. It is respectfully requested that in view of the amended claims, which exclude the presence of a metal foil layer as required by Doi, the anticipation rejection based on Doi be withdrawn.

In regard to the Examiner's comments concerning the positioning of the "consisting of" clause, the clause has been placed immediately following the preamble as suggested. From the previous amendment and this amendment, it is very obvious as to what applicants wish to achieve, i.e., the avoidance of a metallic

layer in the resulting foil composition. If the Examiner believes that the “consisting of” clause is still not adequately place in the claims, applicants attorney would appreciate a teleconference so that this matter can readily be settled instead of the submission of a lengthy office action necessitating a response which simply delays the issuance of a patent.

Claim Rejections – 35 USC § 103

Claim 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over Doi, supra, in view of to Wagner et al. U.S. Patent 6,486,903. Wagner does not make up for the deficiencies of Doi which were pointed out above. Doi clearly requires the presence of a metal layer which Applicants’ do not have in their process. In the claim, Doi, page 2, line 9, ELT (English Language Translation), Doi requires “at least a thin metal foil layer”. On page 4, last par. ELT, where the Doi describes the invention, it is stated “the gist of this invention is ‘a transfer sheet has in the following order on the mold release face of a releasable sheet, a protective layer, which comprises, in an unhardened state, a curable layer with a half-cured ionizing radiation-curable resin which is thermoplastic and a solid body at room temperature, and **at least a thin metal film layer**” (emphasis added). Doi on the last paragraph of page 11 bridging to page 12, points out that this metal layer gives a metal tone appearance and various metals like aluminum, chromium, tin, silver and the like can be used and the thickness of this metal layer is provided. Nowhere in Doi, is there a teaching or even a suggestion that the metal layer can be eliminated. Applicants invention does not include a metal layer and the claims have been amended and are so directed.

Wagner does not make up for the deficiencies of Doi and does not suggest that the metal film layer of Doi could be eliminated. Wagner is simply directed to a transfer printing process for transferring a printed image to a substrate and then curing the transferred image. As the Examiner has recognized, Wagner does not teach or suggest the use of ink jet printing to which Claim 3 is directed. Based on the above discussion, the rejection of Claim 3 in view of Doi and Wagner can not stand and should be withdrawn.

Claim 5 was rejected under 35 U.S.C. 103(a) as being unpatentable over Doi, supra, and Oshima et al. U.S. 5,427,997. Oshima does not make up for the basic deficiencies of Doi that have been pointed out above. Oshima is directed to a heat

transfer film wherein a transparent resin layer of a radiation curable resin is releasably provided on the film and can be laminated to a surface. There is no teaching or suggestion in Oshima that would lead one skilled in the art to combine Oshima with Doi. Oshima simply transfers a transparent coating without an additional layer or an image onto a substrate that has already been provided with an image or something comparable in a separate step. Oshima only transfers a protective layer without any decorative properties of an image or the like to a substrate. In contrast, Applicants' invention as set forth in the amended claims, transfers an image together with a transparent layer of a curable coating composition to a substrate and then cures the transparent layer.

In the rejection, col. 5, lines 28-46 of Oshima were pointed out wherein high transparency particles were added to the radiation curable resin. There are no teachings or explanation in Oshima concerning the reason for the addition of such particles. Why would one skilled in the art add such particles to the composition of Doi without any explanation or motivation? There must be at least some teaching in Oshima that would lead one to use transparent particles in the process of Doi.

The rejection of Claim 5 based on the Doi and Oshima should be withdrawn and the claim allowed.

Claims 6 and 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Doi, supra, and Shvartsman et al. U.S. 6,245,382. Shvartsman is directed to preparing a protective film for a data carrying device, such as a credit card and is not at all related to Applicants' invention directed to an image on a curable transparent coating which is subsequently fully cured after application to a substrate.

Shvartsman does not have an image to transfer but merely forms a protective film. Shvartsman does not make up for the deficiencies of Doi as pointed out above and again there is no teaching or suggestion in Shvartsman that would lead one skilled in the art to combine it with Doi. The rejection of Claims 6 and 7 which are either directly or indirectly dependent on amended Claim 1 should be withdrawn.

Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Doi in view of Bruns et al. U.S. 4,737,322. Bruns is completely unrelated to Applicants' invention and is directed to improved intraocular lens structures for surgical placement in the eyes and merely states that radiation curing or thermal curing can be used. Bruns has nothing to do with Applicants process for applying a foil layer

consisting of a curable transparent coating having an image thereon to a substrate and then curing the coating to provide a substrate having the image that has a transparent coating as is clearly set forth in amended Claim 9 on which Claim 10 is dependent. Certainly, Bruns can not be said to make up for the deficiencies of Doi that have been pointed out above and that also apply to the process Claims 9-12. The rejection based on Doi and Bruns should be withdrawn.

SUMMARY

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, and therefore respectfully solicit a Notice of Allowance. In order to expedite disposition of the case, the Examiner is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Should there be a fee due that is unaccounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

By: 

Hilmar L. Fricke

Attorney for Applicants
Reg. No.: 22,384
Telephone: (302) 984-6058
Facsimile: (302) 658-1192

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